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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,838	01/21/2000	BERTRAND VERDAGUER	TSR1504.1	3464

7590 01/13/2003

THE SCRIPPS RESEARCH INSTITUTE
10550 NORTH TORREY PINES ROAD
MAIL DROP TPC 8
LA JOLLA, CA 92037

EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

21

DATE MAILED: 01/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,838

Applicant(s)

VERDAGUER ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/4/02, 10/7/02.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1631

DETAILED ACTION

Applicant's amendment and request for reconsideration in Paper #14, filed on 2/1/02, and amendments in Papers #16 and 19, filed on 6/4/02 and 10/7/02, respectively, are acknowledged and the amendments entered except that the amendment to claim 2 in Paper #14 is not entered because the response does not provide a clean copy of the amendment.

Currently, claims 1-9 are pending and under consideration.

Applicant's arguments in response to the Office Action, mailed 9/13/01, have been fully considered but they are not deemed to be persuasive. The following rejections and/or objections are either reiterated from the previous Office action or newly added, and constitute the complete set presently being applied to the instant application. Rejections and/or objections not reiterated from previous Office action are hereby withdrawn.

Claim Rejections-35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

This rejection is reiterated from the previous Office action and maintained for reasons of record.

Applicants argue that the specification at pages 19, 20, etc. describes with examples how to make and use a promoter that falls within the scope of claim 1. This is not deemed persuasive because what are described in the specification are for a promoter derived from CsVMV promoter sequence region (SEQ ID NO:3), not for a sequence that is 80% identical to 18 sequential nucleotides of SEQ ID NO:3 as claimed. Apparently, the specification does not even disclose whether a sequence that is 100% identical to 18 consecutive nucleotides of SEQ ID NO:3 possesses a promoter activity in plants. Indeed, the specification describes, by deletion analysis, the critical regions of SEQ ID NO:3 that may possess promoter activity, e.g. a region from -222 to -178, which is 44 bps, and a region from -149 to -116, which is 33 bps. See Table 2 and Fig. 8. The specification, however, does not describe a 18 bp region that possess promoter activity. Thus, the specification may provide guidelines as to how to make a sequence that is 80% identical to 18 consecutive nucleotides of SEQ ID NO:3, it does not provide sufficient guideline as to how to use such sequence for a promoter activity in plants. Further, the GUS promoter assay along with the deletional analysis provided in the specification is merely an invitation to try to find a sequence that is 80% identical to 18 bps of SEQ ID NO:3. Given the skill and knowledge in the art, this is deemed to be trial and error, and hence, undue experimentation.

Claim Rejections-35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1631

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Calvert et al. (IDS document: J Gen Virol. May 1995, Vol. 76, pages: 1271-8).

This rejection is reiterated from the previous Office action and maintained for reasons of record.

Applicants argue that since the sequence disclosed by Calvert et al. is not 100% identical to the sequence of SEQ ID NO:3, the instant invention is thus not anticipated by Calvert et al. This is not deemed persuasive. As set forth in the previous Office action, the instant claims are drawn to any nucleic acid comprising a sequence that is at least 80% identical to 18 consecutive nucleotides of SEQ ID NO:3. As the sequence alignment previously provided to applicants indicates, the sequence of Calvert et al. is 98.2% overall identical to SEQ ID NO:3 which is 524 nucleotides long, and the difference is only two nucleotides at the 5' end and a few at the 3' end. Clearly, the sequence of Calvert et al. comprises a sequence that is at least 80% identical to 18 consecutive nucleotides of SEQ ID NO:3. As set forth in the previous Office action, Berdaguer et al. proved that the sequence disclosed by Calvert et al. does have promoter activity.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL.

Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. §1.136

(a). A shortened statutory period for response to this final action is set to expire three months from the date of this action. In the event a first response is filed within two months of the mailing

Art Unit: 1631


date of this final action and the advisory action is not mailed until after the end of the three-month shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136 (a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than six months from the mailing date of this final action.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to:
Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is (703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.

S. "Joe" Zhou, Ph.D. 

Patent Examiner


MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600